

### **REMARKS**

The Office Action mailed January 7, 2005 has been carefully reviewed and, in view of the above amendments and following remarks, reconsideration and allowance of the application are respectfully requested.

#### **I. Summary of Claims**

Claims 1-48 are currently pending in the application, with claims 1, 15, 27, 35, and 41 being independent claims. Claims 1 and 2 are amended in accordance with the above amendments, and claims 15-25 and 35-40 are withdrawn. Claims 3-48 are unamended and remain, therefore, in their original, as-filed condition.

#### **II. Summary of Rejections**

The following claim rejections were submitted by the Examiner in the outstanding Office Action:

- Claims 1-3, 5-7, 11-14, 27, 29-32, 41, and 43-48 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent Number 5,647,150 to Romanato, et al.;
- Claims 4, 28, and 42 are rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Romanato and either of U.S. Patent Number 4, 785,558 to Shiomura and U.S. Patent Number 4,232,458 to Bartels; and
- Claims 8-10, 33, and 34 are rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Romanato and U.S. Patent Number 3,650,051 to Sass.

#### **III. Discussion of U.S. Patent Number 5,647,150 to Romanato, et al.**

Romanato discloses an article of footwear having a sole 2 and an upper 3. The primary elements of upper 3 are a sock 4 and a thermoplastic material 5 and/or 11. The Applicants wish to point out that reference numerals 5 and 11 appear to refer to the same thermoplastic material. As depicted in Figure 6, sock 4 is formed from three layers that include a grid-like sheet 8, a thermoplastic film 9, and a protective fabric 10. According to Romanato, sheet 8 may be formed of "a material that can be of various kinds (polyester, EVA, leather, metal, or others) provided that it has a grid-like structure and can be coextruded with a film 9 of thermoplastic material (polyurethane, polyethylene, nylon, or others) which may have any weight per unit volume,

provided that it is compatible with the thermoplastic material [11] which will be subsequently injection-molded in place..." (Romanato, column 2, lines 47-54).

Following the formation of sock 4, thermoplastic material 5 and 11 is injection molded to sock 4. Thermoplastic material 5 and 11 flows "through the holes formed in the grid-like sheet 8, during the injection-molding step. Cohesion is thus produced due to melting between this material and the material of the thermoplastic film 9 which lies below the sheet 8, as shown in FIG. 7, where the molded-in-place thermoplastic material is designated by the reference numeral 11; this cohesion ensures the tight mutual coupling of the two components, namely the sock or portion thereof and the shell or upper" (Romanato, column 3, lines 1-10).

With reference to Figure 3, various openings 6 may be formed in thermoplastic material 5 and 11, thereby exposing sock 4. More particularly, openings 6 form apertures in thermoplastic material 5 and 11 that expose both of sheet 8 and film 9.

#### **IV. The Claims Patentably Distinguish Over The Applied Prior Art**

##### ***Discussion of Independent Claim 1***

Independent claim 1 recites an article of footwear having an upper and a sole structure secured to the upper. At least a portion of the upper includes a substrate layer and a web layer. The substrate layer is formed of an air-permeable textile material. The web layer defines a plurality of apertures that expose portions of the textile material of the substrate layer. In addition, the web layer is formed of a polymer material that infiltrates the textile material of the substrate layer and is thereby secured to the substrate layer.

The rejection of independent claim 1 states that Romanato discloses an upper with an air permeable substrate 8 and a web layer 11. Accordingly, the rejection analogizes sheet 8 of Romanato to the substrate recited by independent claim 1. In addition, the rejection analogizes thermoplastic material 5 and 11 to the web layer recited by independent claim 1.

In contrast with Romanato, independent claim 1 recites a combination of elements that include the following: (1) the web layer defines a plurality of apertures that expose portions of the textile material and (2) the web layer infiltrates the textile material of the substrate layer and is thereby secured to the substrate layer. Sheet 8 is not disclosed as being formed from a textile material. Although thermoplastic material 5 and 11 exposes portions of sheet 8, no textile

material is exposed. Furthermore, Romanato does not disclose that thermoplastic material 5 and 11 infiltrates a textile material.

Based upon the above discussion, the Applicants respectfully submit that independent claim 1 is allowable over Romanato. Claims 2-3, 5-7, and 11-14 should be allowable for at least the same reasons. In addition, claims 4 and 8-10 should be allowable as combinations of Romanato and the other references do not remedy the deficiencies discussed above with regard to Romanato.

*Discussion of Independent Claim 27*

Independent claim 27 recites an article of footwear having an upper and a sole structure secured to the upper. The upper includes a textile layer and a polymer layer. The textile layer is formed of a plurality of fibers. The polymer layer forms at least a portion of an exterior surface of the upper, and the polymer layer defines a plurality of apertures that form a web layer and expose portions of the textile layer. In addition, the polymer layer is formed of a polymer material that: (a) infiltrates a first area of the textile layer and extends around the fibers in the first area to secure the polymer layer to the textile layer, the first area corresponding with portions of the textile layer that are immediately adjacent the web layer, and (b) is absent from a second area of the textile layer, the second area corresponding with portions of the polymer layer that are immediately adjacent the apertures, and the second area being air-permeable to permit air transfer through the upper.

In contrast with independent claim 27, Romanato does not disclose a polymer layer that defines a plurality of apertures to expose portions of a textile layer. Both of sheet 8 and thermoplastic material 5 and 11 may define various apertures, but none of these apertures expose a textile. Furthermore, Romanato does not disclose a web layer (which also forms apertures) that extends around fibers in the textile layer to secure the polymer layer to the textile layer.

Based upon the above discussion, the Applicants respectfully submit that independent claim 27 is allowable over Romanato. Claims 29-32 should be allowable for at least the same reasons. In addition, claims 28 and 33 should be allowable as combinations of Romanato and the other references do not remedy the deficiencies discussed above with regard to Romanato.

*Discussion of Independent Claim 41*

Independent claim 41 recites an article of footwear having an upper and a sole structure secured to the upper. At least a portion of the upper includes a textile layer and a polymer layer. The textile layer is formed of a mesh material. The polymer layer exposes portions of the textile layer, and the polymer layer is formed of a polymer material that infiltrates the textile layer and is thereby secured to the textile layer.

In contrast with independent claim 27, Romanato does not disclose a polymer layer that both (1) exposes portions of a textile layer and (2) infiltrates the textile layer. Thermoplastic material 11 exposes portions of sheet 8 and film 9, which are both polymers, for example, but are not disclosed as textiles. In addition, thermoplastic material 11 does not infiltrate a textile.

Based upon the above discussion, the Applicants respectfully submit that independent claim 41 is allowable over Romanato. Claims 43-48 should be allowable for at least the same reasons. In addition, claim 42 should be allowable as a combination of Romanato and either of Shiomura and Bartels does not remedy the deficiencies discussed above with regard to Romanato.


V. Conclusion

In view of the foregoing, the Applicants respectfully submit that all claims are in a condition for allowance. The Applicants respectfully request, therefore, that the rejections be withdrawn and that this application now be allowed.

This Amendment is being timely filed by facsimile transmission on March 30, 2005. Should additional fees or an extension of time be deemed necessary for consideration of this Amendment, such fees or extension are hereby requested and the Commissioner is authorized to charge deposit account number 19-0733 for the payment of the requisite fee. If anything further is desirable to place the application in even better form for allowance, the Examiner is respectfully requested to telephone the undersigned representative at (503) 425-6800.

Respectfully submitted,

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